

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KELVIN RODERICK LAWRENCE,
EDWARD L. KUNZINGER, III, HERMAN RODRIGUEZ
and JAY A. TUNKEL

Appeal No. 2003-1109
Application 09/439,052

ON BRIEF

Before THOMAS, HAIRSTON and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 22-24, which are all of the claims pending in the application.

THE INVENTION

The appellants claim a method, system and computer-usable medium for search refinements. Claim 22, directed toward the method, is illustrative:

22. A computer based method for search refinements, said method comprising:

- (a) marking URL's positive or negative regarding whether a user's needs are met by search results, while URL's remaining unmarked are neutral;
- (b) creating a bookmark set which includes said marked URL's and said positive or negative markings;
- (c) submitting said bookmark set to a search engine; and
- (d) repeating (a) - (c) as often as said user desires, to refine said search results to a manageable level.

THE REFERENCES

Sciammarella et al. (Sciammarella)	5,886,698	Mar. 23, 1999
Ballard	5,987,457	Nov. 16, 1999 (filed Nov. 25, 1997)

Hajime Takano and Terry Winograd (Takano), "Dynamic Bookmarks for the WWW", *HyperText* 98, 297-98 (1998).

THE REJECTION

Claims 22-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ballard in view of Takano and Sciammarella.

OPINION

We reverse the aforementioned rejection.

Each of the appellants' claims requires submitting a bookmark set to a search engine. The only reference relied upon by the examiner for a disclosure or suggestion of this claim limitation is Ballard (final rejection mailed April 9, 2002, paper no. 7, pages 3-4).

Ballard discloses a technique for search refinement wherein, after an initial query phrase is submitted to a search engine and search hit documents are received therefrom, 1) the user categorizes at least one document as "of interest" and at least one document as "not of interest", 2) the computer analyzes each categorized document to find the number of occurrences of each word in the document, 3) the computer produces, as a result of this analysis, a refined query phrase, 4) the user edits the refined query phrase, 5) the user submits the edited refined query phrase to the search engine, and 6) the search engine performs another search and displays the search results (col. 6, lines 18-63; col. 7, lines 1-4).

The examiner argues (answer, page 5):

The Examiner further submits that ordinarily a search engine processes any user submitted search request by examining entered keywords. Therefore, the

claimed limitation of "submitting a bookmark set to a search engine" should inherently submit the search requests in the bookmark set to the search engine for further processing. Appellants' Specification is silent on how the bookmark set is processed by the search engine. For instance, on page 9, lines 27-30 of the Specification merely discloses the following:

"Subsequently, the bookmark set with rating is resubmitted to the search at 306."^[1]

As one skilled in the art would know that search engine does not process a request based on URLs.

Clearly, from the foregoing textual portions, such claimed limitation must be implicit from Ballard's teachings.

Regardless of how the search engine ultimately conducts the search, the appellants' claims require that what is submitted to the search engine is a bookmark set. What Ballard submits to the search engine is a refined query (col. 6, line 56), not a bookmark set. The examiner has not established that the relied-upon disclosure by Ballard of submitting a refined query to a search engine would have fairly suggested, to one of ordinary skill in the art, submitting to the search engine a bookmark set.

^[1] Actually, the disclosure relied upon by the examiner is at page 8, lines 26-29, and is: "Subsequently, the bookmark set with ratings is resubmitted to the search engine and is used to 'Weight and Rank' the next search at 306."

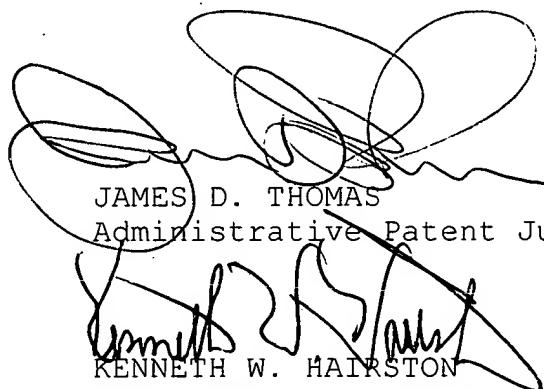
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The examiner, therefore, has not carried the burden of establishing a *prima facie* case of obviousness of the appellants' claimed invention.

DECISION

The rejection of claims 22-24 under 35 U.S.C. § 103 over Ballard in view of Takano and Sciammarella is reversed.

REVERSED



JAMES D. THOMAS)
Administrative Patent Judge)
KENNETH W. HAIRSTON)
Administrative Patent Judge)
Terry J. Owens)
TERRY J. OWENS)
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